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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/248,160	02/09/1999	RICHARD W. CHESTON	RP9-98-096	8471

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EXAMINER
TESFAMARIAM, MUSSIE

ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 03/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/248,160	Richard W. Cheston
Examiner	**Art Unit**
Mussie Tesfamariam	2162

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Mar 4, 2002*.

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-21* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
18) ☐ Interview Summary (PTO-413) Paper No(s). _____
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

DETAILED ACTION

1. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection, Haring 5794052.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claim 1- 3, 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of Thomas, 4685055 and Harding, 5794052.

As per claim 1, Christer disclose in a personal computer system initially loaded with software including selected See fig 1, Pages 4-6. However, he fails to disclose in non-selected software in

unusable form, Harding, 5794052 disclose in non-selected software in unusable form. See col 3, lines 32-37, col 8, lines 3-9. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will load non-selected software. This is because it would improve Christer's system to have a software in unusable form. He also disclose in the selected software later converted and loaded in usable form. See fig 1, PP 4-6. He discloses in selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form. See fig 1, Pages 4-6. However, he fails specifically to disclose in paying royalties on only the selected software. Thomas discloses in paying royalties on only the selected software. See column 1, lines 41-49. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will pay royalties on only the selected software. This is because it would improve Christer's system to have a secured payment.

As per claim 2, Christer disclose in a personal computer system initially loaded with software including selected See fig 1, Pages 4-6. However, he fails to disclose in a software which erases non-selected software from the personal computer. Harding discloses in a software which erases non-selected software from the personal computer. See col 3, lines 32-37, col 8, lines 3-9. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will erase non-selected software.

This is because it would improve Christer's system to remove unnecessary software so it can have enough and fast memory to run or execute programs in a PC.

As per claim 3, Christer disclose in a personal computer includes a software module for converting the selected software from an unusable form into an usable form in response to the selection and the list of selected software. See fig 1, Pages 4-6. However, he fails specifically to disclose in paying royalties on only the selected software. Thomas discloses in paying royalties on only the selected software. See column 1, lines 41-49. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will pay royalties on only the selected software. This is because it would improve Christer's system to have a secured payment.

As per claim 5, Christer disclose in a personal computer includes a software module for converting the selected software from a compressed form to uncompressed form. See Page 4.

As per claim 6, Christer disclose in a software module for selection of the selected software including to input the user's function and to select software for addition or deletion based on the software associated with the user's function. See PP 1, 5-6.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of Thomas, 4685055 and Harding, 5794052 as applied to claim 1 above, and further in view of Halter et al, 5319705.

As per claim 4, Christer disclose in a personal computer includes a software module for converting the selected software from the selected software. See fig 1, Pages 4-6. However, he fails specifically to disclose in a software which is converted from encrypted to unencrypted form. Halter et al disclose in a software which is converted from encrypted to unencrypted form. See the abstract, fig 12, fig 14, col 28, lines 19-26. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will be converted from encrypted to unencrypted form. This is because it would improve Christer's system to read the decoded software.

5. Claim 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of Harding, 5794052, Thomas, 4685055 and www.patents. ibm.com.

As per claim 7, Christer disclose in a personal computer system initially loaded with software including selected See fig 1, Pages 4-6. However, he fails to disclose in non-selected software in unusable form, Harding, 5794052 disclose in non-selected software in unusable form. See col 3, lines 32-37, col 8, lines 3-9. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will load non-selected software. He also disclose in the selected software later converted and loaded in usable form. See fig 1, PP 4-6. He discloses in selected programs stored in the storage device in

usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form. See fig 1, Pages 4-6. However, he fails specifically to disclose in paying royalties on only the selected software. Thomas discloses in paying royalties on only the selected software. See column 1, lines 41-49. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will pay royalties on only the selected software. This is because it would improve Christer's system to have a secured payment. He also fails to disclose in selecting the software programs which are needed for that personal computer. www.patents. ibm.com disclose selecting the software programs which are needed for that personal computer. See Page 1. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will select the software programs which are needed for that personal computer. He also fails to disclose in paying royalties on only the selected software. Thomas discloses in paying royalties on only the selected software. See column 1, lines 41-49. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will pay royalties on only the selected software. This is because it would improve Christer's system to have a secured payment. As per claim 8, Christer disclose in a personal computer system initially loaded with software including selected See fig 1, Pages 4-6. However, he fails to disclose in a software which erases non-selected software from the personal computer. Harding discloses in a software which erases

non-selected software from the personal computer. See col 3, lines 32-37, col 8, lines 3-9. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will erase non-selected software. This is because it would improve Christer's system to remove unnecessary software so it can have enough and fast memory to run or execute programs in a PC.

As per claim 9, Christer disclose in a personal computer system initially loaded with software including selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form. He also disclose in storing the converted software programs in usable form into the storage of the personal computer. See fig 1, Pages 4-6. However, he fails specifically to disclose selecting the software programs which are needed for that personal computer. www.patents. ibm.com disclose selecting the software programs which are needed for that personal computer. See Page 1. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will select the software programs which are needed for that personal computer. This is because it would improve Christer's system to differentiate how to select the necessary software from unnecessary software.

As per claim 10, Christer disclose in a personal computer system initially loaded with software including selected software in unusable form, with the selected software later converted and

loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form. He also disclose in storing the converted software programs in usable form into the storage of the personal computer. See fig 1, Pages 4-6. However, he fails specifically to disclose selecting the software programs for a personal computer includes the step of identifying the job function of the user. www.patents. ibm.com disclose in selecting the software programs for a personal computer includes the step of identifying the job function of the user. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will select the software programs which are needed for that personal computer in the step of identifying the job function of the user. This is because it would improve Christer's system to identify the user's job function.

As per claim 11, Christer disclose in a software module for selection of the selected software including to input the user's function and to select software for addition or deletion based on the software associated with the user's function. See PP 1, 5-6.

6. Claim 12, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of WWW.patents.ibm.com.

As per claim 12, Christer disclose in a personal computer system initially loaded with software including selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form. See fig 1, Pages 4-6. However, he fails specifically to disclose in a module associated with the processor and responsive to the selecting of certain programs to make the selected programs active and usable. www.patents.ibm.com disclose in a module associated with the processor and responsive to the selecting of certain programs to make the selected programs active and usable. See Page 1.Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will select certain programs. This is because it would improve Christer's system to eliminate unnecessary programs from being selected.

As per claim 14, Christer disclose in a personal computer system initially loaded with software including selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable

form. He also disclose in storing the converted software programs in usable form into the storage of the personal computer. See fig 1, Pages 4-6. However, he fails specifically to disclose selecting the software programs for a personal computer includes the step of identifying the function of the user. www.patents. ibm.com disclose in selecting the software programs for a personal computer includes the step of identifying the function of the user. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will select the software programs which are needed for that personal computer in the step of identifying the function of the user. This is because it would improve Christer's system to identify the user's job function.

As per claim 15, Christer disclose in a software module for selection of the selected software including to input the user's function and to select software for addition or deletion programs from a listing of programs which are appropriate for that user. See PP 1, 5-6.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of WWW.patents.ibm.com as applied to claim 12 above, and further in view of Harding, 5794052.

As per claim 13, Christer disclose in a personal computer system initially loaded with software including selected See fig 1, Pages 4-6. However, he fails to disclose in a software which erases non-selected software from the personal computer. Harding discloses in a software which erases non-selected software from the personal computer. See col 3, lines 32-37, col 8, lines 3-9. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the

invention was made to modify the system of Christer such that it will erase non-selected software. This is because it would improve Christer's system to remove unnecessary software so it can have enough and fast memory to run or execute programs in a PC.

8. Claim 16, 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of Thomas, 4685055 and www.patents. ibm.com.

As per claim 16, Christer disclose in a personal computer system initially loaded with software including selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form. He also disclose in storing the converted software programs in usable form into the storage of the personal computer. See fig 1, Pages 4-6. However, he fails specifically to disclose selecting the software programs which are needed for that personal computer. www.patents. ibm.com disclose selecting the software programs which are needed for that personal computer. See Page 1. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will select the software programs which are needed for that personal computer. He also fails to disclose in paying royalties on only the selected software. Thomas discloses in paying royalties on only the selected software. See column 1, lines 41-49. Therefore, it would have been obvious to a person of ordinary skill in the

art at the time the invention was made to modify the system of Christer such that it will pay royalties on only the selected software. This is because it would improve Christer's system to have a secured payment.

As per claim 18, Christer disclose in the step of selecting the subset of programs includes a user input which serves to add to or delete from the list of programs based on user preferences. See PP 1, 5-6.

As per claim 19, Christer disclose in the step of selecting the subset of programs includes a user input which serves to add to or delete from the list of programs based on user preferences. See PP 1, 5-6. However, he fails specifically to disclose in the appropriate royalties can be paid. Official notice is taken that paying appropriate royalties is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include paying royalties because this would improve Christer's system to have better payment method.

As per claim 20, a personal computer system initially loaded with software including selected and non-selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form, with non-selected programs not being converted into usable form. See fig 1, Pages 4-6. However, he fails specifically to disclose in paying royalties for a plurality of personal computers so that a single royalties can be paid for a plurality of personal computers. Thomas discloses in paying royalties

on only the selected software. See column 1, lines 41-49. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will pay royalties on only the selected software. This is because it would improve Christer's system to have a secured payment.

As per claim 21, Christer disclose in preparing a list of the software for each computer along with a list of the user and the functional organization for each personal computer. See PP 1, 3-6.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of WWW.patents.ibm.com as applied to claim 16 above, and further in view of Harding, 5794052.

As per claim 17, Christer disclose in a personal computer system initially loaded with software including selected See fig 1, Pages 4-6. However, he fails to disclose in a software which erases non-selected software from the personal computer. Harding discloses in a software which erases non-selected software from the personal computer. See col 3, lines 32-37, col 8, lines 3-9. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will erase non-selected software. This is because it would improve Christer's system to remove unnecessary software so it can have enough and fast memory to run or execute programs in a PC.

Response to Arguments

10. Applicant's arguments filed on 03/04/02 have been fully considered but they are not persuasive.

A. Applicant's arguments with respect to the lack of Bernerus "selected and non-selected software within a personal computer in a non-usable form and the subsequent rendering of the selected software into a usable form". The Examiner has noted that Bernerus lacks the element in the above. See the paragraph in the above. However, the secondary reference, Harding discloses the missing element. See col 3, lines 32-37, col 8, lines 3-9. In col 3, lines 32-37, Harding specifically discloses in (selected and non-selected software with a personal computer in a non-usable form and the subsequent rendering of the selected software into a usable form).

B. Applicant's arguments with respect to the lack of Bernerus and Thomas to disclose "selected and non-selected software within a personal computer in a non-usable form and the subsequent rendering of the selected software into a usable form". The Examiner has noted that Bernerus lacks the element in the above. However, the Thomas discloses in paying royalties on only selected software. See col 1, lines 41-49.

C. Applicant's arguments with respect to the lack of Harding to disclose "non-selected software in unusable form" Harding discloses in non-selected software in unusable form. See col 3, lines 32-37. In this cited portion, Harding discloses the loading of both selected and non-selected

software into a computer in an usable form. Therefore, the Examiner disagrees with Applicant's arguments.

D. Applicant's arguments with respect to the lack of combination of Christer Bernerus in view of Harding, Thomas and www.patents.IBM. Com to disclose " non-selected software are both loaded into a personal computer in unusable form and wherein the selected software is thereafter converted to usable form" See the reasons given in the above paragraphs.

E. Applicant's arguments with respect to the lack of www.patents.IBM to disclose "loading of unusable software into a computer so that that software may be subsequently rendered usable in a manner set forth within this claim (claim 12). The Examiner disagrees. Because www.patents.IBM explicitly discloses in installing or loading of software. See Page 1.

Therefore, all dependent claims are rejected due to their dependency on the rejected base claims.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Nakashima et al, US Patent 5,875,247, August 01, 1995. System for decrypting encrypted software.

B. Edwards US Patent 6,289,512, December 03, 1998. Automatic Program Installation.

C. Utsumi et al, US Patent 5,809,300, March 12, 1993. Removable storage medium and computer system using the same.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mussie Tesfamariam** whose telephone number is **(703)305-1393**. The examiner can normally be reached on Monday - Friday from 8:00 a.m. to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the **examiner's supervisor, Eric Stamber** can be reached at **(703) 305-8469**.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or **faxed to:**

(703)746-7239, (for formal communications intended for entry)

Or:

(703)746-7240, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

(703)746-7238, (For After-final)

Hand-delivered responses should be brought to **Crystal park II, 2121 Crystal Drive Arlington, Virginia, (Receptionist).**

Mussie Tesfamariam

March 28, 2002

Eric Gravini for ams

STEPHEN GRAVINI
PRIMARY EXAMINER